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Ward & Olivo
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EXAMINER

LE, THIEN MINH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2876

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,137

Applicant(s)

RATHUS ET AL.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 168-262 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 168-262 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The amendment filed on 12/2/2002 has been entered. Claims 168-262 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 168, drawn to the apparatus and method claims 257 and 260, are rejected under 35 U.S.C. 103(a) as being unpatentable over Withmall et al. (herein after Withmall – 4,488,035).

Withmall discloses a passenger-carrying vehicle (for example a bus) in a passenger transport system is equipped with a ticket reader (18) capable of optically reading information printed on a ticket (10) in bar-code and determining whether or not the ticket is valid. A ticket-printer (16) is provided for issuing bar-coded tickets, and both the reader (18) and the printer (16) are microprocessor-based and associated with a memory (14). Fare-table data is stored in the memory (14a), for reference by the ticket-issuing means, data is stored in the memory (14b) for reference by the ticket-checking means, and both the issuing means and the checking means can communicate information to the memory (14c) and (14d) to enable data concerning tickets handled to be stored for subsequent retrieval for management purposes.

According to Withmall, the bar code comprises a code by which information (e.g. a sequence of digits) can be presented in an optically-machine-readable form, each of a plurality of basic elements which are available to constitute the information in code being represented by a uniquely arranged group of marks, or spaces between marks, the marks being in the general form of bars. Withmall also discloses that it becomes practicable to install automatic ticket-checking equipment on passenger-carrying

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vehicles (even on buses), and to provide for a through-ticketing system which can accommodate the complexities of a passenger transport system of substantial size.

Withmall discloses, in a preferred arrangement, that the ticket-checking means is capable of assessing the validity of a ticket by reading information presented to it in a bar-code form on the ticket and comparing the read information with reference information to which it has access. Specifically, the portable ticket -inspecting means comprises an inspection handset 24 which is adapted to be carried within the bus and enables an inspector to check tickets for validity. The portable handset is adapted to read information presented to it on a ticket in bar-code, and is capable of displaying information read from the ticket in a form which can be read by the inspector. The handset is battery-powered and comprises optical bar-code reading means, a microprocessor with programmable memories, a keypad and an illuminated display. The memory of the handset can be programmed with sufficient travel information to enable it to check the validity of tickets presented. Though Withmall discloses data-storing means whereby the reference information can be stored locally, he also discloses that the use of a radio data link might be possible to refer to information stored elsewhere. The system also includes an up-dating means, whereby the reference information can be modified as the vehicle travels, can in a bus, for example, comprise a fare-stage up-date key to be operated by the driver.

The claims differ in calling for the use of the business cards. It would have been obvious to print the bar codes on the business cards. In this case, replacing a printed matter such as a book, a catalog, a magazine, with a business card is merely a

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substitution of an art recognized equivalent; and thus would have been obvious (see MPEP 2144.06 - Art Recognized Equivalence for the Same Purpose).

Claim 169-194 and 258, are rejected under 35 U.S.C. 103(a) as being unpatentable over Withmall (Withmall – 4,488,035; cited above) in view of the general teachings of the prior art of record, (in particular Thacher – 5,083,271; Ertz – 5,003,577; Plummer – 4,992,824].

Regarding claims 169-194 and 258, see the discussions above. Though Withmall discloses the use of a data link, he is silent whether it is used to carry data, video, image, shopping data, online shopping data, etc. It would have been obvious to incorporate to replace one type of data link with another type of data link. Without any unexpected results, the modification is merely an extension of Withmall's teachings to other applications which would be well within skill levels and expectations of an ordinary skilled artisan. References to are cited as evidence showing the conventionality of the use one type of data link in place of another type of data link.

Thacher describes data links as local area networks, data links such as time or frequency shared CATV cable, telephone line videotext channel, etc.

Ertz describes data links as voice links, ISDN, DCP, etc.

Plummer discloses the use of a data link to transmit image and video information.

Claims 195-219, drawn to the apparatus and method claims 259 and 261, are rejected under 35 U.S.C. 103(a) as being unpatentable over Withmall (Withmall –

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4,488,035; cited above) in view of the general teachings of the prior art of record, [in particular Konishi – 5,237,156; Younger – 5,151,687].

Regarding claims 195-219, drawn to the apparatus and method claims 259 and 261, see the discussions above. Though Withmall discloses the use of a bar code, he is silent about the use of other form of code such as a watermark, an invisible barcode, a magnetic code, a printer character, a invisible icon, etc. Official Notice is taken that the use of a watermark, a magnetic code, a printed character, an icon, etc., as a data input source are notoriously well known and old. Without any specific and unexpected result, replacing one source of input with another known source of input would have been design consideration; and would have not been considered novel. Further, references to Konishi and Younger are cited as evidence showing the interchangeability of one type of coding media with another.

Specifically, Konishi discloses a scanner for scanning bar codes, magnetic characters or OCR.

Younger acknowledges several methods of identifying media-taped material subject category, including descriptive words, mnemonics, numeric codes, abbreviations, symbols, or icons.

Claims 220-225, are rejected under 35 U.S.C. 103(a) as being unpatentable over Withmall (Withmall – 4,488,035; cited above).

Regarding claims 249-261, 294 and 297, see the discussions above. The claims differ in calling for the step of encoding individual information, names, organization

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information, etc., in a machine recognizable indica. It would have been obvious to encode these information in the bar code as taught by Withmall. Since a Court has decided that printed matter such as encoding particular information in a code, etc., would not be given patentable weight (*In re Gulack*, 217, U.S.P.Q. 401), encoding individual information, names, organization information, etc., in a machine recognizable indica would not be considered novel.

Claims 262-240 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withmall (Withmall – 4,488,035; cited above) in view of the prior art of record [in particular Ishii – 5,148,297].

Regarding claims 249-261, see the discussions above. The claims differ in calling for the use of various type of display device, i.e. lap top, computer, paper, telephone, book, intelligent terminal, television, etc. Though Withmall discloses the use of a display device, he is silent about the use of alternative displaying devices. Official Notice is taken that the use of a television, a pager, a lap top, a computer, a telephone, a book, etc. for displaying content messages to a user is notoriously old and known. Without any specific and unexpected result, replacing one type of display with another type of display would merely has been a substitution of an art recognized equivalent; which does not enhance the underlying inventiveness concepts of the disclosed invention; and thus is not considered novel. Further, references to are cited as evidence showing the interchangeability of one type of display with another type of display.

Specifically, Ishii discloses a LCD which can be incorporated in a TV, a game, a lap top, an information processing apparatus, or a projection type visual/information apparatus.

Claims 241-256 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withmall (Withmall – 4,488,035; cited above).

Regarding claims 241-256, see the discussions above. The claims differ in calling for the use of various type of code recognition device such as a scanner, a digital mouse, a digital camera, an optical reader, a computer, a television, etc. Though Withmall discloses the use of a bar code reader, he is silent about the use of alternative displaying devices. Official Notice is taken that the use of a scanner, a digital mouse, a digital camera, an optical reader, a computer, a television, etc. for recognizing encoded information are notoriously known and old. Without any specific and unexpected result, replacing one type of feature recognition device another type would merely has been a substitution of an art recognized equivalent; which does not enhance the underlying inventiveness concepts of the disclosed invention; and thus is not considered novel.

Response to Arguments

Applicant's arguments with respect to claims 168-262 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**Le, Thien M.
Primary Examiner
Art Unit 2876
March 10, 2003**